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CVB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/710,962 11/10/00 SEVERINSSON

L 3323-P0001C

024126 PM82/0503
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EXAMINER

SCHWARTZ, C	
ART UNIT	PAPER NUMBER

3613
DATE MAILED:

05/03/01

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/710,962

Applicant(s)

Severinsson

Examiner

Schwartz

Group Art Unit

3613



☒ Responsive to communication(s) filed on Nov 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 25-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 25 is/are rejected.

☒ Claim(s) 26-28 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

1. The preliminary amendment has been received and considered. Claims 1-24 have been canceled (as were originally filed). Claims 25-28 are pending.

Reissue Applications

2. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Specifically applicants have provided a copy of the consent filed in the parent reissue. A new one is needed, dated and signed.

3. Applicants must cross reference this application in the parent reissue case. This can be done by certificate of correction.

4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Note the reissue oath is a copy of the one filed in the parent case and omits required material. It does not identify this specific case. It does not specifically address the error to be corrected in this case; namely the absence of the cover, as per applicants remarks. It lacks a reviewed and understands clause. Applicants should submit a supplemental oath encompassing all

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of the requirements set forth in MPEP 1414 and 37 C.F.R. 1.63 and 1.175. Please make sure it is signed and dated by the inventor.

5. Claims 25-28 rejected as being based upon a defective reissue Oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Oath/declaration is set forth in the discussion above in this Office action.

6. Claim 25 rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Regarding claim 25 note applicants omit claiming the cover as a part of a self sustained unit in a brake mechanism.

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In the parent case the limitation of the cover was claimed in combination with the housing, see patent claim 1.

In the specification at page 2 note line 29 "...but the cover and the rest of the mechanism are also *held together as a unit*...".

At page 6 over to page 7 of applicants remarks in the original parent case 08/817769 applicants stated "Parent claim 1 is amended to better structurally define applicants novel feature wherein the housing and cover members are structured with the entire braking unit carried by the cover independently from the housing to be inserted as a unit.

From these remarks it has become the examiners position that the invention, as originally claimed, is the combination of the housing and the cover and the inner workings of the brake mechanism.

One of the errors in the declaration submitted in the parent reissue states "... that no independent claim is broadly directed to the concept that the two thrust sleeves, cross bar and lever are preassembled as a unit prior to installation in the caliper"... Upon further consideration this supposed error is somewhat confusing because the first set of independent claims (13 and 21) filed with the parent reissue case both had the cover limitation in them. The "error" in the declaration hinted nothing about the omission of the cover as the basis for the reissue. Note also that nowhere in the specification does it state these specific elements (bearing tappets and thrust sleeves) are preassembled without the cover.

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Because this particular issue of recapture has been discussed at some length previously in the parent case and to advance prosecution this action is made final.

Allowable Subject Matter

7. Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

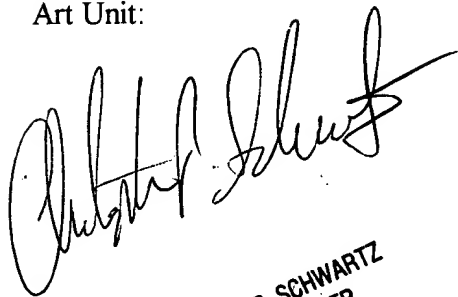
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to Chris Schwartz at telephone number (703) 308-0576..

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A handwritten signature in black ink, appearing to read "Christopher P. Schwartz". The signature is written in a cursive, flowing style with a large initial "C" and a long, sweeping underline.

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER